REMARKS

Claims 1 – 12 are pending. The applicants respectfully request reconsideration and allowance of this application in view of the above amendments and the following remarks.

Claims 1 – 4 were rejected under 35 USC 112, second paragraph, as being indefinite, more particularly, apparently for using "exemplary claim language" (MPEP 2173.05(d). Although the basis for the rejection is respectfully questioned in the comments below, the claims have been amended to improve clarity.

The claims are rejected due primarily to an alleged lack of clarity. A rejection under section 112, second paragraph requires that A) claims set forth subject matter applicants regards as the invention; and B) claims particularly point out and distinctly claim the subject matter of the invention. Since A) relies on subjective interpretation, B) necessarily forms the objective basis for a rejection under this paragraph. Item B) requires an inquiry into the definiteness of the claim, e.g. whether the scope of the claim would be clear to a person of ordinary skill in the art (MPEP 2171).

Applicants submit that since the claims would have been clear to one of ordinary skill in the art as written, an objection would have been a more appropriate means to address clarity issues. The phrase "in the case in which said specific key code to be used in said deciphering means is transmitted from said transmitter to said receiver and registered therein" would be clearly understandable to one of ordinary skill as referring to a situation which is evaluated, and then action is dictated by the case (or situation). Moreover, MPEP 2173.05(d), titled "Exemplary Claim Language ('for example,' 'such as')"and cited in the office action as the basis for the rejection, is clearly not relevant to the language which is rejected. Thus the rejection is improper under 35 U.S.C. § 112 second paragraph.

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Without acknowledging the propriety of the rejection, applicants have amended the claims to improve the clarity thereof. Accordingly claims 1 and 3 have been amended as to matters of form only to address the Examiner's concerns relating to clarity and not for reasons related to patentability. Thus the scope of claims 1 and 3 has not been narrowed within the meaning defined in <u>Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.</u>, 535 U.S. 722 (2002).

Claims 1 – 2 and 5 – 12 were rejected under 35 USC 103(a) as being unpatentable over U.S. Patent No. 6,181,252, Nakano ("Nakano") in view of U.S. patent No. 5,905,445, Gurney et al. ("Gurney"). Claims 3 – 4 were rejected under 35 USC 103(a) as being unpatentable over U.S. Patent No. 5,596,317, Brinkmeyer et al. ("Brinkmeyer") in view of Gurney. The rejections are respectfully traversed for reasons including the following, which are provided by way of example.

Independent claim 1 recites in combination, for example, "enciphering means for enciphering a predetermined code through the use of a specific key code peculiar to each system, said transmitter transmitting the enciphered code produced by said enciphering means;" and "said enciphering means enciphers said specific key code through the use of a default key code stored in said transmitter and said receiver." (See also independent claim 3.)

Thereby, a specific key code is used when an enciphering means in a transmitter of the remote control system enciphers a predetermined code and produces an encipher code. In addition, the enciphering means enciphers the specific key code through the use of a default code stored in the transmitter and receiver. The transmitter transmits those enciphered codes to a receiver in the remote control system.

The office action admits that Nakano "did not explicitly discloses wherein, in a case in which said specific key code to be used in said deciphering means is transmitted from said

transmitter to said receiver and registered therein, said enciphering means enciphers said specific key code through the use of a default key code stored in said transmitter and said receiver, and said transmitter transmits the enciphered specific key code to said receiver." The office action similarly admits that Brinkmeyer "did not explicitly discloses wherein, in a case in which said specific key code to be used in said deciphering means is transmitted from said portable unit to said vehicle-mounted control unit and registered therein, said enciphering means enciphers said specific key code through the use of a default key code stored in said portable unit and said vehicle-mounted control unit, and said portable unit transmits the enciphered specific key code to said vehicle-mounted control unit." Recognizing that Nakano or Brinkmeyer fails to teach and/or suggest the invention as claimed, Gurney is cited in the office action to remedy the deficiencies of Nakano and Brinkmeyer.

To properly reject a claimed invention, the examiner must establish a *prima* facie case of obviousness. To establish a *prima facie* case of obviousness with respect to a claimed invention, all the claim limitations must be taught or suggested by the prior art reference (or references when combined). In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Furthermore, the teaching or suggestion to make the claimed combination and a reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

The examiner bears the burden of establishing this *prima facie* case. In re Deuel, 34 U.S.P.Q.2d 1210, 1214 (Fed. Cir. 1995). If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of patent. In re Oetiker, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

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Gurney was cited as teaching or suggesting various recited elements. The applicants provide herein a selection of some examples of limitations in the claims which are neither taught nor suggested by Nakano (or Brinkmeyer) and/or Gurney, alone or in combination.

For example, in Gurney's keyless entry system, an authentication code (authenticator) corresponds to the recited enciphered code. According to Gurney, "Second the authenticator code is generated as a function of the seed code and the cryptographic key as well as the desired function code." (Col. 2, lines 7 – 10). There is no teaching or suggestion in Gurney to indicate another key as the enciphered code, other than the authenticator code. Apparently, the examiner considers that the seed code, the cryptographic key, and the function code to be used for generating the authentication code in Gurney correspond to the recited specific key code.

However, according to Gurney, the seed code, the cryptographic key, and the function code are not enciphered by a default code as recited. Reference is made to Gurney, Fig. 3. The transmitter transmits an initial value of the seed code the cryptographic key that is not enciphered by the receiver. Therefore, if a person who knows a rule of change algorithm obtains both the initial code of the seed code and the cryptographic key, the person can decipher or decode the authentication code. This is a problem.

Moreover, as illustrated in Gurney, Fig. 4, the transmitter transmits a function code itself that is not enciphered to the receiver. However, the receiver receives the function code, but does not store the received function code therein.

Accordingly, Gurney fails to teach or suggest that the specific key code is enciphered through the use of the default code and the enciphered specific key code is transmitted to the receiver. (E.g., claims 1 and 3.) Furthermore, Gurney fails to teach or suggest that the specific

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key code is enciphered through the use of the registration code and the enciphered specific key code is transmitted to the receiver. (E.g., claims 5 and 9.)

Gurney does not disclose or suggest that the specific key code is enciphered through use of the default code or the registration code and transmitted to the receiver. Hence, Nakano, Brinkmeyer and Gurney, alone or in combination, fail to teach or suggest the combination of features recited in independent claims 1, 3, 5 and 9, when considered as a whole.

With respect to the rejected dependent claims, applicants respectfully submit that these claims are allowable not only by virtue of their dependency from independent claims 1, 3, 5 and 9 but also because of additional features they recite in combination.

Applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicants do not concede that the cited prior art shows any of the elements recited in the claims. However, applicants have provided specific examples of elements in the claims that are clearly not present in the cited prior art.

Applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples applicants have described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, for the sake of simplicity, applicants have provided examples of why the claims described above are distinguishable over the cited prior art.

In view of the foregoing, the applicants submit that this application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions relating to patentability remain, the examiner is invited to contact the undersigned by telephone.

If there are any problems with the payment of fees, please charge any underpayments and credit any overpayments to Deposit Account No. 50-1147.

Respectfully submitted,

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